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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,438

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Raimund Schuetze

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MAYBACK & HOFFMAN, P.A.  
5722 S. FLAMINGO ROAD #232  
FORT LAUDERDALE, FL 33330

EXAMINER

KINGAN, TIMOTHY G

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,438	<b>Applicant(s)</b> SCHUETZE ET AL.	
	<b>Examiner</b> TIMOTHY G. KINGAN	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-23 is/are rejected.
- 7) ☒ Claim(s) 15 and 24-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see p. 9, filed 02/12/2009, with respect to the rejection of claims 24-27 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection of claims 24-27 has been withdrawn.
2. Applicant's arguments filed 02/12/2009 with respect to the remaining claims have been fully considered but they are not persuasive. The claims, as written, read on Landsberger. Landsberger teaches a holding portion which is fully capable of mediating the positioning of the receiving portion within the container by moving said holding portion. To demonstrate, hold the container motionless and move the motor **20**, to which is attached the holding portion **18**, which in turn holds (in a contactless manner) and moves the receiving portion **22** by virtue of a magnetic field.
3. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Further, applicant's argument that the measuring chamber **30** is not designed for "holding" any receiving element is incorrect, in that additives are placed in said cavity (abstract) and are held there, at least until such time as mixing begins, the event of which is not pertinent to an apparatus claim.

Similar considerations reveal that applicant's method claims also read on Landsberger. In operation, the holding portion **18** of Landsberger moves (rotates) in a

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direction relative to the container (rotation, while not linear, nevertheless comprises movement in a direction relative to the container), and in so doing positions the receiving portion **30** in the container: therefore, the receiving portion is held in the container by the holding portion by means of contactless coupling, as required by the method. While not asserted in the rejection statement, examiner notes that the holding portion of Landsberger is fully capable of mediating a linear movement of the receiving portion in the container by movement of the holding portion relative to the container (discussed above), such as would be suggested to one of ordinary skill in the art during positioning of the motor **20** with attached holding portion **18** for the purpose of positioning the receiving portion **22**, by way of example, in the center of the container. By stating that the receiving portion is held in the container by holding portion, examiner does not assert that said receiving portion cannot physically be removed in the presence of the holding portion, but such manner of holding is not required by the claim. As already stated, the receiving portion is held (in a position on the bottom of the container) and moved by virtue of a magnetic field produced by the holding portion.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1-8, 10-12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by K. Landsberger, U.S. Patent 3,749,369 (herein after Landsberger).

Landsberger teaches a magnetic stirrer (holding device) comprising a support structure **14** on which a container is supported, the support structure including a magnetic bar **18** (holding portion) to affect rotation of the mixing and measuring device **12** (col 2, lines 26-32; Figs. 1-3) (receiving portion in a container, said portion coupled in contactless manner to the holding portion). Landsberger further teaches the mixing and measuring device **12** comprises a chamber **27** defined by a cavity **30** (col 2, lines 40-42) for holding additives (col 4, lines 10-12) (cap-like receiving/collecting element, held by receiving portion). The mixing measuring element **12** (receiving portion), held in the container, is fully capable of holding a plurality of cavities **30** (receiving elements) and is preferably made of an inert material such as tetrafluoroethylene polymer (col 2, lines 35-37) (polytetrafluoroethylene). Further, the magnetic bar **18** (holding portion) and the mixing device **12** (receiving portion) are coupled in a contactless manner by magnetism, and the container **16** is open at the top (Fig. 1) and may be transparent (allows illumination of receiving element). With respect to claims 2, 3, 11-12 and 16, as well as the element comprising positioning of the holding portion at multiple locations within the container, examiner notes that intended use language in apparatus claims is not accorded patentable weight where the statement of intended use does not distinguish over the prior art apparatus (MPEP 2111.02). Moreover, the system of Landsberger is fully capable of positioning the receiving portion at multiple locations by moving the motor **20** to which is attached the holding portion **18**.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 9, 13-14 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsberger.

For Claim 9, Landsberger does not teach the material comprising the magnetic bar 18 (holding portion). It would have been obvious to one of ordinary skill in the art at the time of invention to use a material such as Teflon (tetrafluoroethylene polymer) in order to provide a durable and low friction material capable of withstanding prolonged movement.

For Claims 13 and 14, Landsberger does not teach the container taking the form of a Petri dish or a container comprising a base and a cover. It would have been obvious to one of ordinary skill in the art to use a container comprising a Petri dish (with

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a base and a cover), as one of a limited number of alternate shapes, in order to provide the convenience of such inexpensive and disposable containers, without loss or compromise of function. Further, one of ordinary skill in the art would have found desirable to use a dish with a cover in order to allow addition or removal of material before and after operation of the device while maintaining a clean working environment for the container.

For Claims 17-22, Landsberger does not teach the device designed for computer-assisted position. The structure as disclosed in Landsberger is fully capable of use in laser microdissection and computer-assisted adjustment of the magnetic bar (holding portion of the holding device) through control of the motor **20** and it would have been obvious to one of ordinary skill in the art to use such control in order to provide the automation of control, to include changes in rate of operation, provided by a computer and controlling software.

Further, Landsberger does not specifically teach the steps of a method to arrange a receiving and holding portion with respect to each other, the receiving portion being in the container. Examiner notes that such steps are inherent to the structure, in that the device of Landsberger comprises the structural components of the instant claim, fully assembled. It would have been obvious to one of ordinary skill in the art to assemble such device for operation by a method comprising the step of placing the magnetic bar with cavity (receiving portion with receiving element) into the container at the base (which comprises a cover) and in contactless coupling with the magnetic bar **18** (holding portion in the vicinity of the receiving portion) which is outside the base

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(cover) of the container. With regard to the holding portion moving in a direction relative to the container, in operation, the holding portion **18** of Landsberger moves (rotates) in a direction relative to the container (rotation, while not linear, nevertheless comprises movement in a direction relative to the container), and in so doing positions/moves the receiving portion **30** in the container.

For Claim 23, Landsberger does not teach sterilizing the magnetic bar with cavity (receiving portion) prior to assembly of the device. It would have been obvious to one of ordinary skill in the art to sterilize such element in order to provide for prevention of microbial contamination of reagents or biological materials in the container that might adversely alter the reactivity or composition of such materials.

### ***Allowable Subject Matter***

6. Claims 15 and 24-27 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: With respect to claim 15, no prior art of record was found that teaches or fairly suggests a container with first and second membranes that are laser light transmitting and absorbing, respectively, and for which one of ordinary skill in the art would find motivation to combine with the device of Landsberger. With respect to claims 24-27, the claims recite the elements of a method of laser microdissection with use of a device comprising a container with holding and receiving portions that are in contactless



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coupling. No prior art of record teaches or fairly suggests laser microdissection with such device.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY G. KINGAN whose telephone number is (571)270-3720. The examiner can normally be reached on Monday-Friday, 8:30 A.M. to 5:00 P.M., E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571 272-1267. The fax phone number for

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the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TGK

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797